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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,217	07/02/2001	Nobuyuki Tanaka	204080/00	8539

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EXAMINER	
PATEL, SHEFALI D	

ART UNIT	PAPER NUMBER
2621	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/895,217	TANAKA, NOBUYUKI	
	Examiner	Art Unit	
	Shefali D. Patel	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-10,16-20,22 and 23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-10,16-20,22 and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 30, 2005 has been entered.

Response to Arguments

2. Applicant's arguments filed September 30, 2005 (Remarks on page 5) have been fully considered but they are not persuasive.

Applicant argue on page 5 stating "Neither reference teaches a table file as is required in the claims of the present application, where the table file includes an instruction corresponding to bit-data included in an electronic watermark. As such, no combination of Chung and Ryan would make the claimed invention obvious."

The examiner respectfully disagrees.

As stated in the Final Action (June 17, 2005) and in an Advisory Action (September 8, 2005), Ryan et al. (US 6,374,036) discloses a table file defining an instruction corresponding to bit-data included in said electronic watermark. See Figure 3 and its respective portions in the specification of Ryan's. Ryan discloses a table file defining an instruction (no WM, copy_once, Copy_no_more, Copy_never, etc.) corresponding to bit-data (8 bits, 4 bits, etc.) included in the watermark. Ryan discloses at col. 4 that "payload" is the number of changeable bits (usually 8 bits). Further, Ryan discloses what these 8 bits are at col. 4 lines 28-42. Instructions correspond to the bits. See, col. 8 line 61 to col. 9 lines 1-21.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 6-10, 16-20 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al. (US 6,310,962) (hereinafter, "Chung") in view of Ryan, et al. (US 6,374,036) (hereinafter, "Ryan").

With regard to **claim 6** Chung discloses a device that detects an electronic watermark from a compressed original image (Figure 6 and col. 5 lines 63-67), comprising: a circuit reading the compressed original image data (reading/inputting MPEG2 moving pictures as seen in Figure 6); a circuit decoding said compressed original image to produce a decoded data (watermark remover 242, col. 8 lines 48-51); a circuit performing inverse discrete cosine transform (IDCT) for said decoded data (IDCT 224, col. 8 lines 51-59); a circuit detecting electronic watermark data embedded in data for which IDCT has been performed along with the (*bit-data*) (VLC & MUX 236 to output encoding bitstream, Figures 6 and 7, col. 9 lines 4-32).

Chung does not expressly disclose a table data defining an instruction corresponding to bit-data included in a part of an electronic watermark and having a circuit performing processing according to said instruction corresponding to said bit-data. Ryan discloses the watermark containing instruction such as "copy-once," "copy-never," "copy no more," etc. at col. 4 lines 33-36, 64-66, col. 5 lines 22-29; Also see Figure 2 and its respective portions in the specification for a table file with instructions. These instructions are performed according to the electronic watermark. Ryan and Chung are combinable because they are from the same field of endeavor, i.e., watermark encoder/decoder system. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching

of Chung with Ryan. The motivation for doing so is to offer improved economics and security over the existing art as suggested by Ryan at col. 2 lines 30-33 and to prohibit one from copying more than once as disclosed by Ryan at col. 2 lines 15-27. Therefore, it would have been obvious to combine Chung with Ryan to obtain the invention as specified in claim 1.

With regard to **claim 7** Ryan discloses the electronic watermark data as eight-bit data (col. 4 lines 26-28) and said bit-data is four-bit data (col. 4 lines 39-42, col. 5 lines 23-29).

With regard to **claim 8** Ryan discloses characters are displayed according to said instruction corresponding to said bit-data (col. 5 lines 59-62 where "copy-once," "copy-never," "copy no more," etc. is being displayed).

With regards to **claims 9-10,** it would have been obvious matter of design choice to modify Ryan's reference by having an instructions to access a website on the internet or start an application process since applicant has not discloses that having an instructions to access a website on the internet or start an application process solves any stated problem or is for any particular purpose and it appears that Ryan's invention of having instructions for "copy-once," "copy-never," "copy no more," etc. would perform equally well with having an instructions to access a website on the internet or start an application process (as disclosed in Ryan at col. 16 lines 22-25).

Claim 16 recites identical features as claim 6 except claim 16 is a method claim. Thus, arguments similar to that presented above for claim 6 is equally applicable to claim 16.

Claim 17 recites identical features as claim 7. Thus, arguments similar to that presented above for claim 7 is equally applicable to claim 17.

Claim 18 recites identical features as claim 8. Thus, arguments similar to that presented above for claim 8 is equally applicable to claim 18.

Claims 19-20 recites identical features as claims 9-10. Thus, arguments similar to that presented above for claims 9-10 are equally applicable to claims 19-20.

Claim 22 recites identical features as claim 6 except claim 22 is a computer readable recording medium claim (Figures 6-7 of Chung). Thus, arguments similar to that presented above for claim 6 is equally applicable to claim 22.

Claim 23 is a broad version of claim 6. Thus, arguments similar to that presented above for claim 6 is equally applicable to claim 23.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,798,893 – Digital watermarking Techniques, see table 108 in Figure 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D. Patel whose telephone number is 571-272-7396. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on (571) 272-7695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shefali D Patel
Examiner
Art Unit 2621

December 28, 2005

JOSEPH MANCUSO
SUPERVISORY PATENT EXAMINER